

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Application of: Philip S. Siegel
Serial No.: 09/817,353
Filing Date: March 26, 2001
Group Art Unit: 3627
Examiner: Joseph A. Fischetti
Title: SYSTEM AND METHOD FOR SINGLE-ACTION
RETURNS OF REMOTELY PURCHASED MERCHANDISE

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. The Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

REMARKS

In the prosecution of the present Application, the Examiner's rejections and assertions contain clear errors of law, including a failure to establish *prima facie* rejections in a Final Office Action. To assist the Panel in the review of this Request, Applicant submits the following brief summary of selected portions of the prosecution history of the Application.

I. Brief Summary of Selected Portions of Prosecution History

a. Final Office Action

In a Final Office Action of June 15, 2005, all claims were rejected under 35 U.S.C. §102 and 103. Specifically, Claims 1-7 and 9 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application No. 2001/0032143 issued to Haseltine ("*Haseltine*"). Additionally, Claims 1-9 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Haseltine* in view of U.S. Patent 6,321,211 issued to Dodd ("*Dodd*").

Applicant subsequently submitted a Response to Final Office Action on July 25, 2005. In the Response, the claims were not amended. Rather, Applicant argued that the claims in their present form were allowable over the cited references. In particular, Applicant argued that the Final Office Action failed to set forth a *prima facie* rejection of the claims. Applicant also argued that the Examiner's use of *Haseltine* with regard to the § 102 rejection was contradictory to the Examiner's use of *Haseltine* with regard to the § 103 rejection.

b. Advisory Action

In an Advisory Action of August 19, 2005, the Examiner's only substantive comments were: (1) that the amendment would not be entered for purposes of appeal; (2) that the amendment is not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; (3) that the "Section 103 rejection is made in the alternative and statements used therein cannot be used against 102 rejection;" and (4) that "No hindsight [is] found in 103 rejection given motivation between references."

II. Errors of Record:

a. Failure to Establish a Prima Facie Rejection

Most notable of the legal errors present in the examination of the Application is a failure of the Final Office Action to establish a *prima facie* rejection of all the claims in the application under either § 102 or § 103.

Applicant demonstrated in the Response to the Final Office Action submitted on July 25, 2005, that *Haseltine*, whether considered alone or in combination with *Dodd*, does not disclose, teach, or suggest each and every limitation of Applicant's claims. Specifically, Applicant has shown that *Haseltine* does not disclose, teach, or suggest "displaying the transaction history associated with the identified user to the user on a computerized system," as recited in Claim 1. Additionally, Applicant has shown that neither *Haseltine* nor *Dodd* disclose, teach, or suggest "initiating a returns process in response to a selection, by the user, of a transaction displayed in the transaction history, the selection comprising input into the computerized system," as recited in Claim 1.

Because Applicant continues to believe that Applicant's previous arguments with respect to *Haseltine* and *Dodd* have merit, Applicant directs the Panel's attention to the following portions of Applicant's Response to Final Office Action:

- **Page 8, 3rd paragraph through Page 9, 2nd paragraph:** Arguing that the Examiner has failed to provided a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic (the "displaying" step recited above) necessarily flow from the teachings of *Haseltine*.
- **Page 9, 3rd paragraph through Page 10, 1st paragraph:** Arguing that *Haseltine* does not disclose, teach, or suggest the "displaying" step recited above.
- **Page 10, 2nd paragraph through Page 11, 1st paragraph:** Noting that the Examiner has acknowledged in the § 103 rejection of the claim that *Haseltine* does not disclose the "initiating" step recited above.
- **Page 11, 5th paragraph through Page 12, 2nd paragraph:** Arguing that *Dodd* also does not disclose the "initiating" step recited above.

Furthermore, Applicant respectfully disagrees with the Examiner's statement in the Advisory Action that the "Section 103 rejection is made in the alternative and statements used therein cannot be used against 102 rejection." Regardless of the basis of a prior-art rejection, the prior-art rejection may only be maintained where the reference or combination of references disclose each and every limitation of Applicant's claims. Either a references discloses a claim limitation or it does not. In this case, the Examiner has acknowledged with respect to the § 103 rejection of Claim 1 that *Haseltine* does not disclose, teach, or suggest "initiating a returns process in response to a selection, by the user, of a transaction displayed in the transaction history, the selection comprising input into the computerized system." This simply cannot be reconciled with the fact the Examiner continues to maintain a § 102 rejection of Claim 1 under *Haseltine*.

Additionally, Applicant has repeatedly demonstrated that the recited features are absent from the disclosure of *Haseltine*. In addition to those portions of the Response to Final Office Action listed above, Applicant directs the Panel to Page 11, paragraph 4 through Page 12, paragraph 2 of the Response to Office Action submitted on November 23, 2004, for further support for this proposition. Because Applicant has also shown that *Dodd* does not cure the demonstrated and acknowledged deficiencies of *Haseltine*, Applicant respectfully submits that the rejection of Claim 1 is improper under either § 102 or § 103.

b. Improper Combination of References

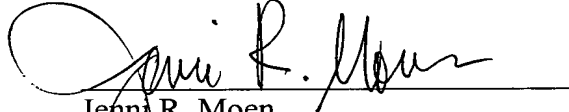
Applicant also demonstrated in the Response to the Final Office Action submitted on July 25, 2005, that the proposed *Haseltine-Dodd* combination is improper. Because Applicant continues to believe that Applicant's previous arguments with respect to the combination of *Haseltine* and *Dodd* have merit, Applicant directs the Panel's attention to Page 12, 3rd paragraph through Page 13, 3rd paragraph of the Response to the Final Office Action. The Examiner's statement in the Advisory Action that "No hindsight [is] found in 103 rejection given motivation between references" is an inadequate response to Applicant's arguments in the Response to Final Office Action, which demonstrated that the inconsistent objectives of *Haseltine* and *Dodd* teach away from their proposed combination.

CONCLUSION

As a *prima facie* rejection has not been established against Applicant's claims and as the combination of *Haseltine* and *Dodd* is improper, Applicant respectfully requests a finding of allowance of Claim 1, together with dependent Claims 2-9.

To the extent necessary, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,
BAKER BOTTS L.L.P.
Attorneys for Applicant


Jenni R. Moen
Reg. No. 52,038
(214) 953-6809

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Correspondence Address:

Customer Number: **05073**